

REMARKS

Claims 1, 13, 29, 33, 34 and 39 have been amended and Claim 28 has been canceled.

Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-32 and 39 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of written description (see Official Action, at page 2, lines 1-20). It is alleged that amending Claim 1 to recite "a flavoring-release additive upstream of the sorbent including at least one flavoring," is not supported by the specification.

Independent Claim 1 has been amended to remove the phrase "upstream of the sorbent." Because amending Claim 1 obviates the basis for the rejection, Applicants respectfully request the withdrawal of the rejection of Claims 1-32 and 39.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-32 and 39 stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. As recited in independent Claim 1, it is allegedly unclear how the electrical smoking system "generates smoke without combustion."

Independent Claim 1 and other claims recited "without combustion" have been amended to clarify that smoke is generated without ignition of the tobacco-containing mat. Applicants respectfully request the withdrawal of the rejection of Claims 1-32 and 39.

Claim Rejection Under 35 U.S.C. §102

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. §102(b) in view of McCarty (U.S. Patent No. 3,744,496) (see Official Action, at page 4, lines 1-22 through page 5, lines 1-2).

MPEP §2131 provides that a claim is deemed anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (emphasis added; MPEP quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2USPQ2d 1051, 1053 (Fed. Cir. 1987)). Thus, a proper *prima facie case of anticipation* requires that a single reference, provided by an Examiner, discloses each of the claimed elements as interpreted by one of ordinary skill in the art.

Applicants traverse the rejection and assert that a *prima facie* case of anticipation has not been established. Applicants assert that *McCarty* does not disclose the electrically heated cigarette of Claim 1 in that *McCarty* does not disclose the combination of features recited in **Claim 1**, as amended, comprising (emphasis added):

a tobacco rod including a free-flow filter and a tobacco-containing mat having a tubular form,

In contrast, *McCarty*'s cigars and cigarettes were designed for a different purpose, particularly "to provide a wrapper for the tobacco column of cigarettes, cigars and the like ..." (emphasis added, column 2, lines 5-8). Relevant portions of *McCarty* is provided below (column 2, lines 20-50):

The carbon filled wrappers of this invention may be made using an ordinary paper furnish such as pulped wood or flax fibers to which is added a sufficient quantity of pulverized carbon filler. The furnish of fiber pulp and carbon filler is then used to make a paper sheet on conventional paper-making machines. The particular fiber furnish from which the carbon filled

wrapper is made is not critical and any of the cellulosic fiber pulps used in paper making can be employed. The fiber pulps customarily used to make paper wrappers for cigarettes or the tobacco materials used to make cigar wrap are preferred. Thus, in addition to wood and flax fibers, the furnish may be pulped tobacco stalks or stems to which is added the carbon filler or the carbon may be added to the furnish used in making reconstituted tobacco sheets for cigar wrap.

The fiber pulps or the tobacco materials used to make cigar wrap are preferred. Thus, in addition to wood and flax fibers, the furnish may be pulped tobacco materials used to make cigar wrap are preferred. Thus, in addition to wood and flax fibers, the furnish may be pulped tobacco stalks or stems to which is added the carbon filler or the carbon may be added to the furnish used in making reconstituted tobacco sheets for cigar wrap.

Ideally, the carbon filled paper is used as an inner wrap under a normal outer wrap for the tobacco column of the cigarette or cigar. Conventional cigarette paper or cigar wrap is used as the outer wrapping for the smoking article. Such a combination reduces the tobacco weight necessary to make a satisfactory product, increases the tobacco rod firmness and does not alter the appearance of the cigarette or cigar since the outer wrap hides the grey carbon filled inner liner.

In the case of cigarettes the construction is such that the carbon filled paper inner wrap can be sealed or unsealed. If left unsealed, the sealed outer wrap holds the inner wrap around the circumference of the cigarette.

Claim 1 recites an electrically heated cigarette which includes a tobacco rod having a free-flow filter and a tobacco-containing mat. Absent a disclosure of all recited elements of independent Claim 1, a *prima facie* case of anticipation has not been established. Applicants respectfully request the withdrawal of the rejection of Claims 1, 2, 4, and 5.

Claim Rejections Under 35 U.S.C. § 103

MPEP §2143 provides that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure." (MPEP sec. 2143 quoting *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

-I-

Claims 1-15, 17-23, 25-32, 34-37 and 39 stand rejected under 35 U.S.C. §103(a) over Shi (U.S. Publication No. 2006/000531) in view of McCarty. (See Official Action, at page 5, lines 3-27). Applicants traverse the rejection and assert that a *prima facie* case of obviousness has not been established. Applicants assert that *Shi* and *McCarty*, in combination, do not disclose the combination of features recited in independent Claim 1 directed to an electrically heated cigarette. In the above section, Applicants have explained the deficiencies of *McCarty*. In the previous Official Action, the Examiner acknowledges that "As correctly pointed out by Applicant in the Office Action reply Dated October 27, *Shi* fails to disclose 'a tobacco mat' in the electrically heated cigarette." Thus, *Shi* and *McCarty*, in combination, do not disclose all recited elements of Claim 1, which includes "a tobacco rod including a free-flow filter and a tobacco-containing mat having a tubular form" Absent a disclosure of all recited elements of independent Claim 1, a *prima facie* case of obviousness has not been established. Applicants respectfully request the withdrawal of the rejection of Claims 1-15, 17-23, 25-32, 34-37 and 39.

-II-

Claim 7 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* as applied to Claim 6 and in view of *Wakamiya* (U.S. Patent No. 6,056,974).

Applicants traverse the rejection of dependent Claim 7 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 7 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 7 is patentable over *Shi*, *McCarty*, and *Wakamiya*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 7.

Claim 16 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* and further in view of paragraph [0067] on page 17 of Applicants' specification.

Claim 16 depends from Claim 14. Applicants traverse the rejection of dependent Claim 16 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 16 depends by way of dependency from Claim 14) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 16 is patentable over *Shi*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 16.

Claim 19 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* as applied to Claim 14 and in view of *Bradley* (U.S. Patent No. 4,195,645).

Claim 19 depends from Claim 14. Applicants traverse the rejection of dependent Claim 19 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 19 depends by way of

dependency from Claim 14) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 19 is patentable over *Shi*, *McCarty*, and *Bradley*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 19.

Claims 23-25 stand rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* in view of *Demain* (U.S. Patent No. 5,144,946).

Claims 23-25 depend directly or indirectly from Claim 22 which depends from Claim 1. Applicants traverse the rejection of dependent Claims 23-25 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claims 23-25 depend) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claims 23-25 are patentable over *Shi*, *McCarty*, and *Demain*. Thus, Applicants respectfully request the withdrawal of the rejection of Claims 23-25.

Claim 27 stands rejected under 35 U.S.C. §103(a) over *Shi* and *McCarty* and further in view of paragraphs [0171] and [0173] at page 16 of Applicants' specification. Claim 27 depends from Claim 22 which depends from Claim 1. Applicants traverse the rejection of dependent Claim 27 because a *prima facie* case of obviousness has not been established for independent Claim 1 (from which Claim 22 depends) for reasons set forth in the above section. Absent a disclosure of all elements recited in independent Claim 1, Applicants assert that Claim 27 is patentable over *Shi* and *McCarty*. Thus, Applicants respectfully request the withdrawal of the rejection of Claim 27.

Claim 33 stands rejected under 35 U.S.C. §103(a) over *Shi* in view of McCarty and further in view of "old and well known practice." The **Official Action** sets forth the Examiner's reasoning as (at pages 17-18):

Although *Shi* does not explicitly set forth the components of a smoking system as including both a cigarette and a lighter, it would be obvious to one of ordinary skill in the art engaged in the smoking of a cigarette as taught by *Shi* to pair the disclosed smokable cigarette with a heat source or "lighter" capable of igniting said smokable cigarette. Inclusively, said cigarette and said lighter constitute the claimed smoking system.

Applicants traverse the rejection and assert that a *prima facie* case of obviousness has not been established. Applicants assert that *Shi* in view of McCarty does not disclose the combination of features recited in independent **Claim 33** directed to an electrical smoking system comprising (emphasis added):

at least one electrically heated cigarette including:

a tobacco rod including a free-flow filter and a tobacco-containing mat having a tubular form.

Applicants assert that *Shi* in view of McCarty does not disclose the combination of features recited in independent Claim 33 directed to an electrical smoking system. *Shi* in view of McCarty fails to disclose a tobacco rod including a free-flow filter and a tobacco mat as a component of an electrically heated cigarette of the electrical smoking system as recited in Claim 33. Absent a disclosure of all recited elements of independent Claim 33, a *prima facie* case of obviousness has not been established. Applicants respectfully request the withdrawal of the rejection of Claim 33.

C O N C L U S I O N

From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of present application may be expedited.*

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 24, 2007

By:


Peter K. Skiff
Registration No. 31917

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620